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Intellectual Property and Technology Law Dept.
35 Waterview Drive
P.O. Box 3000
Shelton, CT 06484

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PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/674,135
Filing Date: September 29, 2003
Appellant(s): MONSEN ET AL.

Ronald Reichman
(Reg. No. 26,796)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/15/08 appealing from the Office action mailed 9/20/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

U.S. Patent Application Serial No. 10/732,152 entitled "Method for Indicating the Payment of Customs Duties".

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

A substantially correct copy of appealed claim 1 appears on page 22 of the Appendix to the appellant's brief. The minor errors are as follows: The phrase "the first country post office" should be "a first country post office" in line 4.

(8) Evidence Relied Upon

| | | |
|--------------|-----------------|--------|
| 2002/0073040 | SCHWARTZ ET AL. | 6-2002 |
| 6,125,357 | PINTSOV | 9-2000 |
| 6,415,336 | SANSONE | 7-2002 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 6-7, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz et al., U.S. Publication No. 2002/0073040.

3. **As per claim 1**, Schwartz discloses a method for paying for mail to be delivered from a sender in a first country to a recipient in a second country, comprising the steps of:

affixing a first indicia containing a number to mail for payment of carrier fees for a first country post office (Schwartz: Figure 7, “705” and “709”, “US Postage” and “Meter 12345678901234”; paragraph 0059);

affixing a second country indicia containing a number to the mail for payment of the carrier fees for the second country courier (Schwartz: Figure 7, “710” and “708”; Figure 8, “801b”, “801c”, and “801d”; paragraph 0011, “the payee of the money order represented by the indicium to be a courier (e.g., FedEx) different from the postal authority”; paragraphs 0059;

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0061-0064 – The Examiner notes, it is basic knowledge of one skilled in the art at the time of the invention to recognize that FedEx is an international carrier that delivers mail to a second country. Thus, the Examiner interprets barcode 710 to be a second country indicia.), and

debiting a meter for the payment of the carrier fees for the first country post office and the carrier fees for the second country courier (Schwartz: Figure 1; paragraphs 0010; 0059).

4. The Examiner notes, Schwartz discloses an indicia containing a unique number (Schwartz: paragraphs 0055; 0061, “payer’s credit card account number”). Schwartz does not disclose a first indicia containing a unique number. However, It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the first indicia of Schwartz to have included an indicia containing a unique number as disclosed by Schwartz for the advantage of identifying a particular mail item.

5. The Examiner notes, Schwartz discloses a country post office (Schwartz: Figure 7, “705”, “US Postage”; paragraph 0059). Schwartz does not disclose a second country post office.

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Schwartz to have included a second country post office as disclosed by Schwartz because the post office is one carrier that a customer can select out of many in the competitive mail shipping industry.

6. **As per claim 2**, Schwartz discloses the method of claim 1 as described above. Schwartz further discloses wherein the first indicia is a post office postal indicia (Schwartz: Figure 7, “705”; paragraph 0059).

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7. **As per claim 3**, Schwartz discloses the method of claim 1 as described above. Schwartz further discloses a post office postal indicia (Schwartz: Figure 7, “705”; paragraph 0059).

Schwartz does not disclose the second indicia is a post office postal indicia.

8. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Schwartz to have included the second indicia is a post office postal indicia as disclosed by Schwartz because the post office is one carrier that a customer can select out of many in the competitive mail shipping industry.

9. **As per claim 6**, Schwartz discloses the method of claim 1 as described above. Schwartz further discloses the first and second indicia are affixed to mail by a personal computer meter (Schwartz: Figure 1; paragraphs 0008; 0023). Schwartz further discloses the use of postage meters to print postage indicia on mail pieces (Schwartz: paragraph 0007). Schwartz does not disclose the indicia are affixed to mail by a postage meter in the secure postage payment method.

10. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Schwartz to have included indicia are affixed to mail by a postage meter as disclosed by Schwartz because the postage meter is an effective machine used in the industry to meter mail.

11. **As per claim 7**, Schwartz discloses the method of claim 1 as described above. Schwartz further discloses wherein the first and second indicia are affixed to mail by a personal computer meter (Schwartz: Figure 1; paragraphs 0008; 0023).

12. **As per claim 12**, Schwartz discloses the method of claim 1 as described above. Schwartz further discloses reporting the payment of carrier fees for affixing the first indicia to the first country post office (Schwartz: paragraphs 0010; 0059); and reporting the payment of

carrier fees for affixing the second indicia to the second country post office (Schwartz: paragraphs 0010; 0059). The Examiner notes, in paying the US Post Office and the payee for service, it is implied that both the US Post Office and the payee receive some form of a report or notification indicating a payment made.

13. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz et al., U.S. Publication No. 2002/0073040 in view of Pintsov, U.S. Patent No. 6,125,357.

14. **As per claim 8**, Schwartz discloses the method of claim 1 as described above. Schwartz further discloses information contained in the first indicia and the second indicia (Schwartz: paragraphs 0059-0069); examining the first indicia information and the second indicia information (Schwartz: paragraph 0070); determining whether the first indicia, and the second indicia affixed to examined mail are legitimate (Schwartz: paragraph 0070; The Examiner notes, Schwartz discloses the step of verifying indicia (bar code 710). Schwartz does not disclose verifying human readable indicia 705 (first indicia). However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Schwartz to have included verifying human readable indicia 705 for the advantage of ensuring that postal data is correct prior to mailing a mail piece.).

15. Schwartz does not disclose storing indicia information in a database and comparing the information stored in the database with information examined to determine whether the indicia affixed to the examined mail are legitimate.

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16. Pintsov discloses storing indicia information in a database and comparing the information stored in the database with information examined to determine whether the indicia affixed to the examined mail are legitimate (Pintsov: col. 8, lines 18-43).

17. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Schwartz to have included storing indicia information in a database and comparing the information stored in the database with information examined to determine whether the indicia affixed to the examined mail are legitimate as disclosed by Pintsov for the advantage of identifying any mail that may be fraudulent.

18. **As per claim 9**, Schwartz in view of Pintsov discloses the method of claim 8 as described above. Schwartz further discloses the unique number contained in the first indicia and the number contained in the second indicia as described above. Schwartz does not disclose utilizing the number contained on indicia to determine whether indicia affixed to the examined mail are legitimate.

19. Pintsov discloses utilizing the number contained on indicia to determine whether indicia affixed to the examined mail are legitimate (Pintsov: col. 8, lines 18-43).

20. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Schwartz in view of Pintsov to have included utilizing the number contained on indicia to determine whether indicia affixed to the examined mail are legitimate as disclosed by Pintsov for the advantage of identifying any mail that may be fraudulent.

21. **As per claim 10**, Schwartz in view of Pintsov discloses the method of claim 8 as described above. Schwartz further discloses canceling the first indicia and the second indicia (Schwartz: paragraph 0070).

22. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz et al., U.S. Publication No. 2002/0073040 in view of Pintsov, U.S. Patent No. 6,125,357 and further in view of Sansone, U.S. Patent No. 6,415,336.

23. **As per claim 11**, Schwartz in view of Pintsov discloses the method of claim 8 as described above. Schwartz further discloses the first and second indicia as described above. Schwartz in view of Pintsov does not disclose marking the indicia with a visible ink to distinguish a used indicia from an unused indicia.

24. Sansone discloses marking the indicia with a visible ink to distinguish a used indicia from an unused indicia (Sansone: Figure 7c; col. 7, lines 22-24).

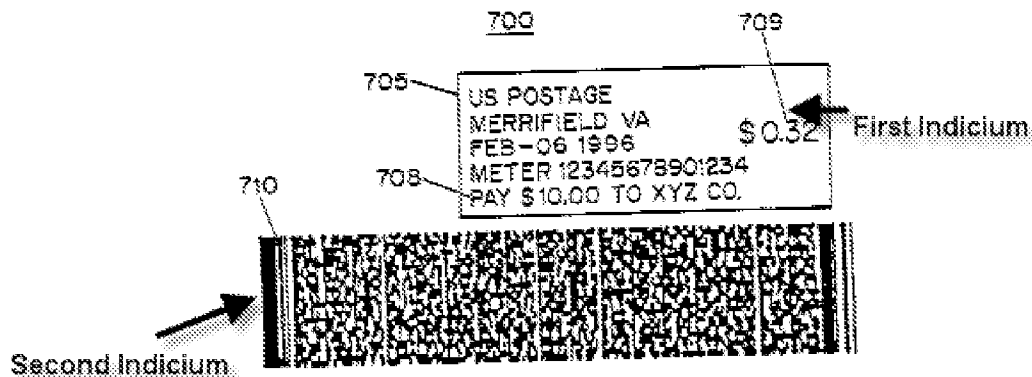
25. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Schwartz in view of Pintsov to have included marking the indicia with a visible ink to distinguish a used indicia from an unused indicia as disclosed by Sansone for the advantage of providing a clear indicator that an indicia is cancelled.

(10) Response to Argument

Appellant Argument I

Regarding claims 1, 6, 7, and 12, Appellant submits that Schwartz discloses the printing of one postal indicium and argues the reference does not disclose or anticipate the printing of a first country postal indicium and a second country postal indicium with a postage meter as claimed. Appeal Brief for Appellant, pgs. 13-14.

The Examiner respectfully disagrees. Schwartz teaches printing mail indicia that includes a first country postal indicium (Schwartz: Fig. 7, "705"; paragraph 0059, See \$0.32 for US Postage) and a second postal indicium (Schwartz: Fig. 7, "710"). Note that bar code indicia 710 contains the same information in portion 708, which is an amount paid to a payee such as FedEx or any other courier (with emphasis) (Schwartz: Fig. 7; Fig. 8, "801b", "801c", and "801d"; paragraphs 0011; 0059-0063; 0077). The Examiner notes, one skilled in the art would recognize that FedEx is an international carrier that delivers mail to a second country. The applied reference has been interpreted and applied assuming basic knowledge of one of ordinary skill in the art. According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that, which is disclosed therein. Furthermore, the phrase "any other courier" as recited by Schwartz includes a second country postal carrier. As such, bar code indicium 710 is the second country postal indicium. Figure 7 of Schwartz is provided below.



Appellant Argument II

The Examiner stated in the Final Office Action, "It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Schwartz to have included the second indicia is a post office postal indicia as disclosed by Schwartz because the post office is one carrier that a customer can select out of many in the competitive mail shipping industry." Appellant argues, "A customer does not have the right to select a first country postal indicia for the payment of carrier fees for the first country post office and select; a second country postal indicia for the payment of carrier fees for the second country post office." In addition, Appellant submits, "While it is true that a country post office is one carrier that the customer can select. The country post office selects the other carrier." Appeal Brief for Appellant, pgs. 13 and 15.

It is noted that Appellant's claims do not have any limitations regarding whether or not a customer has the right to select a postal indicia or a carrier. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In*

re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993), *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67USPQ2d 1947, 1950 (Fed. Cir. 2003) (“Interpretation of descriptive statements in a patent’s written description is a difficult task, as an inherent tension exists as to whether a statement is a clear lexicographic definition or a description of a preferred embodiment. The problem is to interpret claims in view of the specification’ without unnecessarily importing limitations from the specification into the claims.”), and *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d1865, 1868 (Fed. Cir. 2004) (“Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim.”).

Appellant Argument III

Appellant argues, “Schwartz and/or Pintsov taken separately or together do not disclose or anticipate examining the first indicia information and the second indicia information: and comparing the information stored in the database with the information examined to determine whether the first indicia, and the second indicia affixed to examined mail are legitimate as claimed in claim 8.” Appeal Brief for Appellant, pg. 18.

The Examiner respectfully disagrees. Schwartz teaches examining indicia information on a mail piece using a bar code scanner or an optical character recognition scanner and storing mail piece indicia information in a database (Schwartz: paragraphs 0052; 0055). Schwartz further teaches preventing fraudulent use of postage indicium and verifying the indicium information (Schwartz: paragraphs 0050; 0056; 0070). Schwartz does not explicitly teach comparing the

information stored in the database with the information examined to determine whether the indicia affixed to examined mail are legitimate.

However, Pintsov teaches a known technique of comparing mail piece identification numbers to identification numbers stored in a database in order to verify and check a mail piece for suspected fraud (Pintsov: col. 3, lines 56-58; col. 8, lines 36-42). This known technique is applicable to the method of Schwartz as they both share characteristics and capabilities, namely, they are directed to mail processing and preventing fraud.

One of ordinary skill in the art would have recognized that applying the known technique of Pintsov would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Pintsov to the teachings of Schwartz would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such comparison and verification means into similar systems. Further, applying the mail piece comparison and verification steps to Schwartz with generated mail piece indicia accordingly, would have been recognized by those of ordinary skill in the art as resulting in an improved system that would allow for preventing indicia misuse and postal fraud.

Appellant Argument IV

Appellant argues “Schwartz and/or Pintsov taken separately or together do not disclose or anticipate utilizing the unique number contained in the first indicia and utilizing the unique number contained second indicia and comparing the information stored in the database with the

information examined to determine whether the first indicia, and the second indicia affixed to examined mail are legitimate as claimed in claim 9.” Appeal Brief for Appellant, pg. 19.

The Examiner respectfully disagrees for reasons similar to those of argument III as described above. It is noted that claim 9 recites that only one indicia contains a unique number. Schwartz teaches examining indicia information on a mail piece using a bar code scanner or an optical character recognition scanner and storing mail piece indicia information in a database (Schwartz: paragraphs 0052; 0055). Schwartz further teaches using a unique number in the indicia and other additional numbers (Schwartz: Fig. 7, “705” and “710”; paragraphs 0059; 0061). Schwartz further teaches preventing fraudulent use of postage indicium and verifying the indicium information (Schwartz: paragraphs 0050; 0056; 0070). Schwartz does not explicitly teach comparing the information stored in the database with the information examined to determine whether the indicia affixed to examined mail are legitimate.

However, Pintsov teaches a known technique of comparing mail piece identification numbers to identification numbers stored in a database in order to verify and check a mail piece for suspected fraud (Pintsov: col. 3, lines 56-58; col. 8, lines 36-42). This known technique is applicable to the method of Schwartz as they both share characteristics and capabilities, namely, they are directed to mail processing and preventing fraud.

One of ordinary skill in the art would have recognized that applying the known technique of Pintsov would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Pintsov to the teachings of Schwartz would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such comparison and verification means into

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similar systems. Further, applying the mail piece comparison and verification steps to Schwartz with generated mail piece indicia accordingly, would have been recognized by those of ordinary skill in the art as resulting in an improved system that would allow for preventing indicia misuse and postal fraud.

Appellant Argument V

Regarding claim 11, Appellant submits that Sansone only discloses canceling one indicium, wherein applicant cancels two indicia. Appeal Brief for Appellant, pg. 20.

The Examiner respectfully disagrees. First, it is noted that the Sansone patent number that Appellant provides on page 19 of the Appeal Brief is incorrect. The correct patent number for Sansone is 6,415,336.

Schwartz teaches the first and second indicia (Schwartz: Fig. 7). Schwartz does not teach marking the indicia with a visible ink to distinguish a used indicia from an unused indicia. However, Sansone teaches a known technique of providing a cancellation mark on a mail piece indicium (Pintsov: col. 3, lines 56-58; col. 8, lines 36-42). This known technique is applicable to the method of Schwartz as they both share characteristics and capabilities, namely, they are directed to indicia and mail piece processing. In addition, it is within the capabilities of one of ordinary skill in the art to provide a cancellation mark on more than one indicium in order to prevent reuse of any invalid indicia.

One of ordinary skill in the art would have recognized that applying the known technique of Sansone would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Sansone to the teachings of Schwartz would

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have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such indicia marking means into similar systems. Further, applying cancellation marks to Schwartz with generated mail piece indicia accordingly, would have been recognized by those of ordinary skill in the art as resulting in an improved system that would invalidate all used indicia.

Examiner's Note

It is noted that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Furthermore, a suggestion or motivation to combine references is an appropriate method for determining obviousness, however it is just one of a number of valid rationales for doing so. The Court in KSR identified several exemplary rationales to support a conclusion of obviousness which are consistent with the proper “functional approach” to the determination of obviousness as laid down in *Graham*. KSR, 550 U.S. at ___, 82USPQ2d at 1395-97. Also see MPEP § 2141 and § 2143. Moreover, “A person of ordinary skill in the art is also a person of ordinary creativity, not an automaton.” KSR International Co. v. Teleflex Inc., 550 U.S. ___, ___, 82 USPQ2d1385, 1397 (2007). “[I]n many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *Id.* Office personnel may also

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take into account “the inferences and creative steps that a person of ordinary skill in the art would employ.” Id. at ___, 82 USPQ2d at 1396.

(11) Related Proceeding(s) Appendix

An Appeal to the USPTO Board of Appeals has been filed in copending U.S. Patent Application Serial No. 10/732,152 entitled “Method for Indicating the Payment of Customs Duties” which may directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Eric Liou/
Examiner, Art Unit 3628

Conferees:

John Hayes, SPE 3628
/JOHN W HAYES/
Supervisory Patent Examiner, Art Unit 3628

Vincent Millin /VM/
Appeals Practice Specialist